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IN THE
Supreme Court of the United States

OCTOBER TERM, A. D. 1947.

No. 162

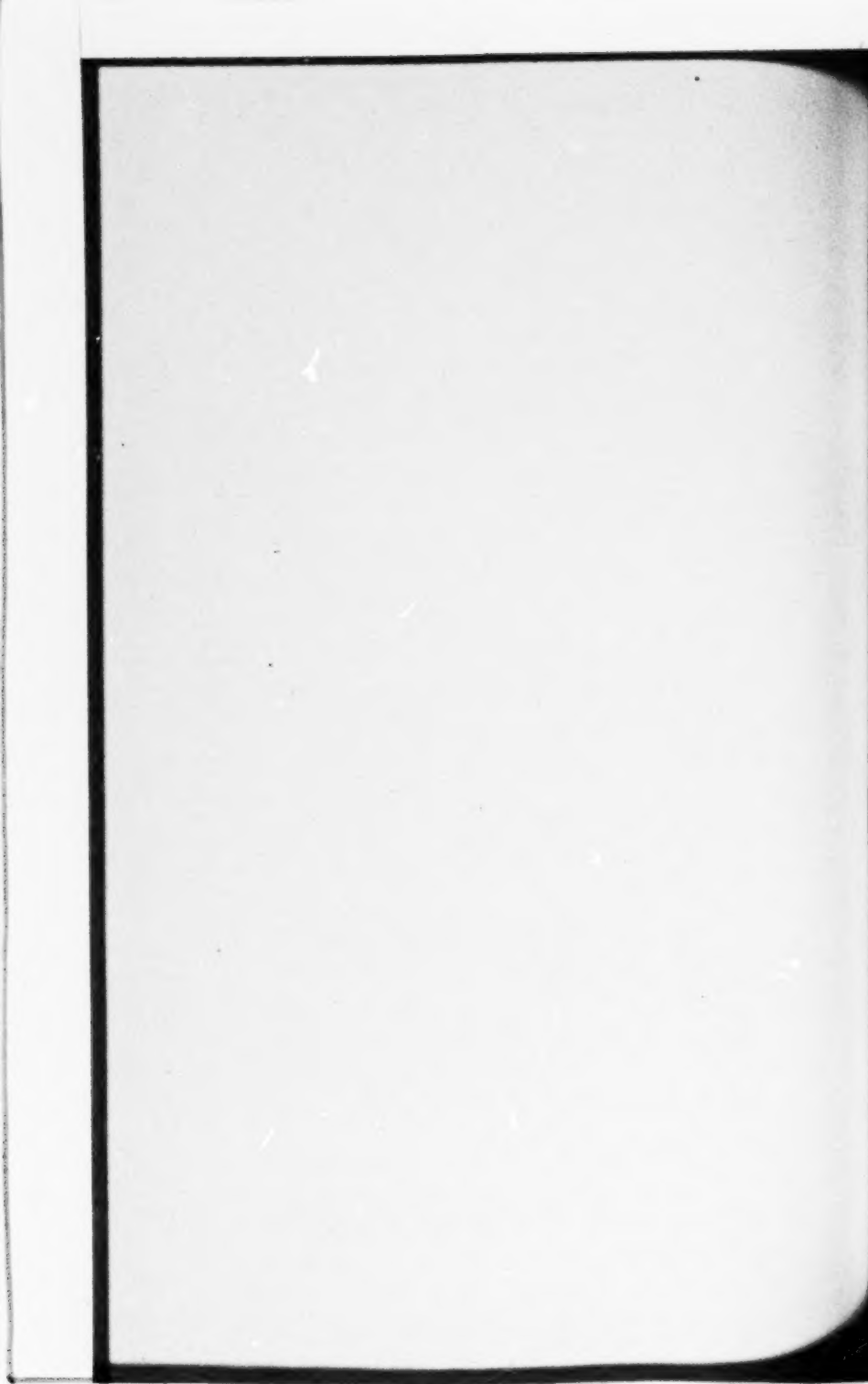
EXCEL AUTO RADIATOR COMPANY,
Petitioner,

vs.

THE BISHOP AND BABCOCK MANUFACTURING
COMPANY,
Respondent.

**PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE SIXTH CIRCUIT.**

✓
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FOSTER YORK,
Counsel for Petitioner.



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*To the Honorable Frederick N. Vinson, Chief Justice of the
United States, and the Associate Justices of the Supreme
Court of the United States:*

Your petitioner respectfully shows:

Summary Statement of Matter Involved.

Petitioner (plaintiff below) seeks a review of a judgment of the United States Circuit Court of Appeals for the Sixth Circuit rendered May 3, 1948 (R. 458), rehearing denied June 2, 1948 (R. 477). That judgment affirmed a judg-

ment (R. 438) of the District Court of the United States for the Northern District of Ohio, Eastern Division, holding all 13 claims of *Mayo* patent No. 2,322,041 (R. 135) valid, and all claims excepting claim 11, infringed,—with this exception that the Circuit Court of Appeals held claim 6 invalid.

This action was initiated Sept. 21, 1945 by petitioner upon filing its complaint under Sec. 274d, Judicial Code (Federal Declaratory Judgment Act) for a declaratory judgment to have said patent declared invalid.

The Court will find (please see the brief) that this cause is quite analogous to one in which two Courts of last resort have differed.

The device involved is one used in the great majority of automobiles and is called a heater, in which there is provision for two streams of heated air, one to heat the car, and the other to aid in windshield defrosting. It is two separate and distinct devices driven by one motor but mounted in *one* framework.

The patent in suit was clearly indicated as invalid in a decision by the Court of Customs and Patent Appeals in February 1944 (*Sperry v. Payne, Sperry v. Teschner*, 141 F. (2nd) 816), based upon the existence and successful testing in the year 1935 of certain devices constructed by petitioner and now before this Court (Petitioner's Exhibits 1 to 6 incl.).

The existence and successful testing of these devices in 1935 *antedates* the earliest invention date (R. 62) *claimed* by Mayo (Mayo claimed Feb. 1936, Ex. N, p. 14).

The decision as to which review is sought revitalizes this patent and enjoins petitioner from making the devices made by it since 1935, that is, the very devices now before this Court, whose *existence* in 1935 has been found by six tribunals,—twice by the Patent Office Interference Examiner,

both decisions (R. 328, 330; R. 353, lines 1 to 7; R. 355, 358), twice by the Patent Office Board of Appeals, both decisions (R. 344; R. 365), and twice by the Court of Customs and Patent Appeals, both decisions, *Sperry v. Aufiero, et al.*, 134 Fed. (2nd) 174, 179; *Sperry v. Payne, Sperry v. Teschner*, 141 (2nd) 816, 821, 822. These same 1935 devices now before the Court are fully and completely operative to perform their functions. The Court of Customs and Patent Appeals in 141 Fed. (2nd) 816, 822 and 827, held that they were successfully tested in 1935. See also R. 460.

The decision of the Circuit Court of Appeals overruling the Court of Customs and Patent Appeals is in direct conflict with the doctrine of *Morgan v. Daniels*, 153 U. S. 120, 38 L. Ed. 657. The District Court refused to consider the Patent Office Interference record on which the six decisions establishing the existence of the devices is based (R. 432). The Court of Appeals upheld such ruling by the District Court on the ground that Mayo was not bound by such prior use testimony, and refused to follow the findings of the Court of Customs and Patent Appeals because of what it believed was controlling new evidence, and based its decision on an entirely erroneous (visually demonstrable) assumption of fact which the Court mistakenly believed followed from the new evidence. The erroneously assumed fact was never asserted by respondent and when the error was called to the attention of the Court by petition on rehearing, respondent made no effort to justify the Court's erroneous finding. The petition was summarily dismissed.

The decision runs counter to *Halliburton v. Walker*, 329 U. S. 1, 91 L. Ed. 15. The interpretation of that decision by the Court of Appeals of the Sixth Circuit is clearly erroneous, and is contrary to the interpretation given by other circuits. See particularly *Refrigerator Patents Corp. v. Stewart-Warner*, 159 Fed. (2nd) 972.

The second decision by the Court of Customs and Patent Appeals finding invention by Sperry prior to Mayo's earliest claimed date was such notice as required Mayo either to disclaim or else test the issue in another proceeding following that decision. Mayo chose to test the issue by filing a counterclaim in the instant suit. Claim 6 was held invalid by the Court of Appeals. Under the doctrine of *Triplett, et al. v. Lowell, et al.*, 297 U. S. 638, 643, the entire patent is invalid. See also, *Radio Condenser Co. v. General Instrument*, 65 F. 2d 459; *Ensten v. Simon Ascher & Co.*, 282 U. S. 445; *Maytag Co. v. Hurley Machine Co.*, 307 U. S. 243.

The device of the patent in suit and petitioner's device operate upon entirely different principles and are not capable of being comprehended by one patent.

The patent merely combines in one framework two prior art devices which accomplish the same functions.

The patent covers such devices broadly, and as its use is confined to the automobile trade which is concentrated in the Sixth Circuit, no other litigation is foreseeable.

Questions Involved.

1. Is it proper for a Circuit Court of Appeals to overrule a decision by the Court of Customs and Patent Appeals indicating patent invalidity when the only basis for its ruling is an erroneous assumption of fact, the error of which is not denied by respondent, and which error is visually demonstrable by examination of two small exhibits before this Court? *Morgan v. Daniels*, 153 U. S. 120. The District Court made no like finding of fact and even the respondent did not at any time assert the existence of such erroneously assumed fact. Four Patent Office Tribunals and the Court of Customs and Patent Appeals differ with the Court of Appeals for the Sixth Circuit. Petition for

Rehearing was denied *without comment* even though respondent's reply to Petitioner's Petition for Rehearing did *not* deny but instead *accepted* Petitioner's contention that the Court had made an erroneous assumption.

2. Is it proper to hold infringement of a patent by a device operating upon an entirely different principle, *Halliburton v. Walker*, 329 U. S. 1, simply because the patent contains "means" claims which can be made to read on the device?

3. Is the aggregation of two prior art devices (automobile heaters) into one framework and driving them by one motor instead of two, a patentable invention?

4. Is it proper for a Circuit Court of Appeals to fail to hold a patent invalid in its entirety after it has held invalid one claim which assignee of patent failed to disclaim after assignee had been given notice of invalidity of all claims by a previous decision of the Court of Customs and Patent Appeals? *Triplett, et al. v. Lowell, et al.*, 297 U. S. 638, 646.

Reasons for Granting the Writ.

1. The four Patent Office decisions and the two decisions of the Court of Customs and Patent Appeals being in conflict with the decision of the Circuit Court of Appeals for the Sixth Circuit constitutes a situation analogous to that in which two Circuit Courts of Appeals differ, *Morgan v. Daniels, supra*. Especially is this true where the basis for overruling the Court of Customs and Patents Appeals is a visually determinable error of fact *assumed* by the Appellate Court, unsupported by any findings by the District Court and neither urged by Respondent at any time nor defended in its reply to our petition for rehearing which was summarily denied. The point is one which has therefore never been argued. This single point on which the decision of the Court of Appeals overruling the Court of

Customs and Patent Appeals was based is the statement by the Court that the fan blower element of Exhibit 1, which was part of the 1935 Sperry development, was identical with a fan blower element made by "Midwest" which was not made until 1936. A mere *visual* inspection of the blower element made by Midwest and said Exhibit 1 is sufficient to dispel such fallacy. Both are before this Court.

2. The District Court and the Circuit Court of Appeals failed to give effect to the Patent Office Interference decisions and thus violate the dictates of *Morgan v. Daniels*, 153 U. S. 120.

3. The decision revitalizes a patent whose invalidity was indicated years ago and which invalidity was confirmed by the Court of Appeals as to one claim; and thus the decision violates the disclaimer doctrine of *Triplett, et al. v. Lowell, et al.*, 297 U. S. 638, 646.

4. As automobile heaters are installed almost exclusively in the Sixth Circuit no other litigation involving the patent is foreseeable.

5. The decision is in conflict with the doctrine of *Halliburton v. Walker Corp.* as the device held to infringe operates upon a new and entirely different principle from that of the patent in suit. The interpretation of *Halliburton v. Walker* decision by the Court of Appeals for the Sixth Circuit nullifies the decision by the Supreme Court in the Sixth Circuit and is contrary to the interpretation in other circuits, particularly the Seventh Circuit. See *Refrigerator Patents Inc. v. Stewart Warner*, 159 Fed^{2d} 972.

6. The devices in question are standard articles of trade and the patent in suit would blanket them until 1960.

Wherefore, Petitioner prays that a Writ of Certiorari issue under the seal of this Court directed to the United States Circuit Court of Appeals for the Sixth Circuit, sit-

ting at Cincinnati, Ohio, commanding said Court to certify and send to this Court on a day to be designated, a full and complete transcript of the record, and all proceedings of the said Circuit Court of Appeals had in the case numbered and entitled on its docket No. 10,548, *Excel Auto Radiator Company, Appellant v. The Bishop and Babcock Manufacturing Company, Appellee*, to the end that this cause may be reviewed and determined by this Court; that the judgment therein of the said Circuit Court of Appeals be reversed by this Court; and that the cause be remanded to that Court with directions to hold the patent in suit invalid, and such other and further relief as this Court may deem proper.

MAX W. ZABEL,

FOSTER YORK,

Counsel for Petitioner.

BRIEF IN SUPPORT OF PETITION.

Jurisdiction.

Petitioner would invoke the jurisdiction of this Court under Section 240(a) of the Judicial Code as amended by the Act of February 13, 1925, U. S. C. Title 28, Sec. 347, to review a judgment of the United States Circuit Court of Appeals for the Sixth Circuit dated May 3, 1948 (R. 458), in a suit based upon the Declaratory Judgment Act, U. S. C. Title 28, Sec. 400, Judicial Code, Sec. 274(d), alleging jurisdiction under the Act of March 3, 1911, c. 231, Sec. 24, par. 7, Stat. 1902, U. S. C. Title 28, Sec. 41(7), and in which a counterclaim was filed charging infringement of United States Letters Patent. Petition for rehearing was denied June 2, 1948 (R. 477). This petition is presented within three months from and after the denial of petition for rehearing.

Statement.

A short historical statement may here be desirable. Mayo (inventor of the patent in suit) filed his patent application March 28, 1936. Petitioner's employee and assignor (Sperry) filed his patent application (for a device operating upon a novel and entirely different principle) on March 20, 1937. Patent Office interference proceedings were instituted between these two and seven other patent applicants.

The Patent Office Interference Examiner held (R. 328, lines 12 et seq.) that the devices now before this Court had been in existence "in co-operative relation at least by the end of October, 1935", and then proceeded to declare

Mayo (whose earliest date was February, 1936) as the first inventor on the extremely technical ground that (R. 339, ninth line from the bottom) Sperry's testimony had not shown *sufficient* testing, although the said devices in the same form constituted Sperry's *commercial* device.

The Patent Office Board of Appeals (R. 345) affirmed, so that we have a second tribunal holding the existence of the Sperry devices in 1935.

On appeal to the Court of Customs and Patent Appeals that Court affirmed on the same technical ground of insufficient testing (*Sperry v. Aufiero, et al.*, 134 F. (2nd) 174, 179 (5)).

Three tribunals have thus far held that the devices before this Court were in existence in 1935, but relied upon the technical Patent Office ground of insufficient testing. The Courts in general do not favor the same degree of strictness. *Sinko Tool and Mfg. Co. v. Automatic Devices Corp.*, 157 Fed. (2nd) 974.

In the course of the above proceedings, on or about February, 1937 (about eleven months after the filing of the Sperry patent application), *Payne* filed a patent application on a device operating upon the *Sperry* principle. That patent application was *under the control of Respondent*. Patent Office interference proceedings were instituted between the *same* Sperry patent application (involved in the Mayo interference), the *Payne* patent application, and several other applicants.

Sperry relied upon the *same* devices in this second interference proceeding but further elaborated his evidence as to testing. The Patent Office Interference Examiner again held that the devices were in existence in 1935 (R. 353 line 1). He then said that they were *probably* tested (R. 353, line 16 from bottom) but, not sufficiently.

The Board of Appeals again affirmed such decision.

On appeal to the Court of Customs and Patent Appeals (*Sperry v. Payne*, *Sperry v. Teschner*, 141 F. (2nd) 816) the additional Sperry evidence with regard to testing was held sufficient and Sperry prevailed as to his specific device. Since *all* evidence by Sperry related to these 1935 devices, such decision by the Court is in effect a reversal of its previous opinion. *The Circuit Court of Appeals in referring to this decision by the Court of Customs and Patent Appeals says: "but the Court of Customs and Patent Appeals reversed these decisions (141 Fed. (2nd) 816), holding that the evidence established Sperry's reduction to practice in 1935 by adequate testing of his models, and awarded priority to Sperry"* (R. 460). The opinion of the Circuit Court of Appeals in regard to this ruling of the Court of Customs and Patent Appeals states: "It would however be persuasive if relevant and if based on the same evidence as that presented here" (R. 460, lines 28 thru 30). The Court (R. 460, last three lines) further says, "Also though we gave careful consideration to the findings of fact of this expert court, we have before us testimony, not previously introduced which, if it had been before the patent tribunals, might have changed the decision of the Court of Customs and Patent Appeals in the last case (141 Fed. (2nd) 816)." The testimony referred to by the Court is testimony on which the Court made an error of fact which is apparent by visual examination of two exhibits: Ex. 1 and Ex. NN. This was called to the Court's attention on Petition for Rehearing; it was not denied by respondent in its reply. The Court denied the Petition for Rehearing without comment.

That this erroneously *assumed* fact had a determining character upon the judgment of the Circuit Court of Appeals, is evident from the statement (R. 460, lines 16

and 17) that "this question has a fundamental bearing on the outcome of the case".

The Court of Appeals justifies its exclusion of the prior inventorship evidence on the ground that *Mayo* is not bound by it because not a party to the second interference proceeding, even though respondent was in control of both *Mayo* and *Payne* patent applications.

Morgan v. Daniels, however, applies when the assignee is the same even though one of the inventors (*Mayo*) was not a party in the final interference. *Radio v. Radio*, 293 U. S. 1.

The *Mayo* patent having issued, the Court of Customs and Patent Appeals could take no action with regard to it, and unless this Court grants Certiorari it will for over a decade blanket the industry. Petitioner is not here asking for a ruling that the patent be granted in behalf of *Sperry*, as such action is foreclosed by the first decision of the Court of Customs and Patent Appeals.

Petitioner's only recourse to continue making what it had made since prior to *Mayo*'s date was the petition for declaratory judgment.

Specification of Errors.

1. The Circuit Court of Appeals erred in overruling the Court of Customs and Patent Appeals by not following the well-established doctrine of *Morgan v. Daniels*, 153 U. S. 120.

2. The Circuit Court of Appeals erred in affirming the District Court in excluding the stipulated records in the group of interferences won by petitioner, on the ground that the evidence showing invalidity of the patent in a companion interference (under the control of Respondent) to which *Mayo* however was not a party, "does not bind this

Court, since Mayo was not a party to those proceedings". The fact that Mayo was not a party does not make the evidence irrelevant nor take this case out of the ruling of *Morgan v. Daniels*, *Radio v. Radio*, *supra*.

3. The Court erred in applying the rule that the burden was upon Petitioner to show that the Mayo patent was not invalid, whereas, if *Morgan v. Daniels* had been applied, as it should have been, the burden would have been the opposite. The "new evidence" (R. 460, last line; 461, first line) does not satisfy the "thorough conviction rule" which the Court applied contrary to its correct application (R. 461, lines 4-7).

4. The Circuit Court of Appeals based its decision overruling the Court of Customs and Patent Appeals on an erroneous *assumption of a fact* not urged by Respondent, as to which there had been no finding by the District Court, never argued, not supported by Respondent in its reply to Petitioner's petition for rehearing, not clarified by the Court in its summary denial of the petition, and as to which six tribunals (four in the Patent Office and twice by the Court of Customs and Patent Appeals) have held the contrary. The error of the Court's assumption is obvious by a mere *visual* inspection of two small simple elements which are before this Court as exhibits.

5. The Circuit Court of Appeals erred in not applying the doctrine of *Triplett, et al. v. Lowell, et al.*, 297 U. S. 638, 646, relating to disclaimers.

6. The Circuit Court of Appeals erred in not following the doctrine of *Halliburton v. Walker*, 329 U. S. 1, and in its interpretation thereof differing from the interpretation placed on said doctrine by the Circuit Court of Appeals for the Seventh Circuit in *Refrigeration Patents Corp. v. Stewart-Warner*, 159 F. (2nd) 972.

7. The Circuit Court of Appeals erred in holding Mayo

patent No. 2,322,041 valid and thus revitalizing said patent, whose invalidity had been indicated several years before.

8. The Circuit Court of Appeals erred in holding the Mayo patent No. 2,322,041 infringed by the complained-of Sperry heater.

9. The Circuit Court of Appeals erred in affirming the Judgment of the District Court.

ARGUMENT.

I. The Circuit Court of Appeals for the Sixth Circuit, in Sustaining the Validity of the Patent in Suit Departed from the Principles of *Morgan v. Daniels*, 153 U. S. 120.

The reasons why we respectfully contend that this case comes under the doctrine of *Morgan v. Daniels*, 153 U. S. 120 and is parallel to one in which two Circuit Courts of Appeals have differed are the following: Petitioner's employee, Sperry (since deceased) constructed various embodiments of the device in suit in (as held by four Patent Office Tribunals and twice by the Court of Customs and Patent Appeals) the year 1935. The earliest date to which Mayo (inventor of the patent in suit) could and did lay claim is February 1936 (R. 62, Ex. N, p. 14). Mayo filed his patent application March 28, 1936, and Sperry filed his on March 20, 1937. The two patent applications being co-pending the Patent Office declared interference proceedings between said Mayo, said Sperry and seven other co-pending applications, to determine the question of priority of invention.

Upon final hearing and after the taking of testimony by all parties the Patent Office Interference Examiner held (R. 328, 330) that the Sperry devices now before this Court had been in existence since October 1935, prior to Mayo's earliest date of February 1936, but awarded priority to Mayo over Sperry on the technical ground that the devices had been insufficiently tested (R. 328, 330), despite the fact that those same devices constituted Petitioner's commercial product and are now as then in operable condition.

The Patent Office Board of Appeals affirmed the decision (R. 343), and so did the Court of Customs and Patent Appeals (*Sperry v. Aufiero, et al.*, 134 F. 2d 174). The pat-

ent in suit thereupon issued to Mayo, thus settling the controversy in so far as it concerned who as between *Mayo and Sperry* obtained a patent on the broad claims in issue. Sperry's assignor is therefore here not asking for a patent in its own behalf.

The important thing however is the fact that *so far* three technically informed tribunals have held the Sperry devices to have been in existence in 1935.

The said Sperry patent application disclosed a device which, although performing the same functions as the Mayo device, operated upon an entirely different and novel principle not disclosed in the Mayo patent application.

During the course of the above proceedings, Payne, and also Teschner filed patent applications on a device following Sperry's principle, and the *said Sperry application* became involved in a second interference proceeding initiated by the Patent Office. The interference proceedings in behalf of Payne and also Teschner were under the control of Respondent (R. 29, 34).

During this second proceeding further testimony was added in behalf of Sperry to further elaborate his tests of the 1935 devices, but the Patent Office Interference Examiner again held that although the devices were in existence in 1935, the tests were insufficient and awarded priority to Payne (R. 362, and on other counts to Teschner, R. 380). The Patent Office Board of Appeals affirmed (R. 366, 372, 385).

Upon appeal to the Court of Customs and Patent Appeals said Court reversed the Patent Office ruling (*Sperry v. Payne, Sperry v. Teschner*, 141 F. (2nd) 816) and ruled that these 1935 Sperry devices *had* been sufficiently tested. That the Court of Customs and Patent Appeals so held is conceded by the Circuit Court of Appeals in its opinion (R. 460, lines 3 to 8) saying "*but the Court of Customs and Patent Appeals reversed these decisions (141 F. (2nd) 816), holding that the evidence established Sperry's reduction to*

practice in 1935 by adequate testing of his models, and awarded priority to Sperry." Yet it is in respect to this very testimony of the second interference proceeding that the Court of Appeals affirmed the District Court in excluding it on the ground of irrelevancy and immateriality.

There were thus three additional rulings to the effect that the Sperry devices before this Court were in existence in 1935, making six decisions in all.

This later decision by the Court of Customs and Patent Appeals thus nullified its prior decision in the Sperry-Mayo interference by holding that Sperry's invention date in reality was in 1935, and hence prior to Mayo's earliest alleged date of February 1936. It established prior invention by Sperry and thus clearly indicated invalidity of the Mayo patent which had in the meantime issued.

We respectfully submit that the six decisions by technically qualified tribunals, being in conflict with the decision of the Circuit Court of Appeals, constitutes a case parallel to one in which two Circuit Courts of Appeals have differed upon the question of patent validity. Thus where the Court of Appeals refuses to apply *Morgan v. Daniels* its decision is subject to review by the Supreme Court.

And also more particularly is this true when the Circuit Court of Appeals bases its finding (R. 463, lines 3 and 4 from bottom of page) that "Sperry did not prove conception earlier than the fall of 1936" upon an erroneously assumed fact, whose non-existence can be established by mere visual inspection of two small simple elements in evidence.

II. The Circuit Court of Appeals for the Sixth Circuit, in Affirming the Judgment of the District Court in Rejecting the Evidence as to Interferences 75,056, 75,057 and 75,058 Departed from the Principles of *Sinclair v. Interchemical Company*, 325 U. S. 327, 330.

The Court went far afield from *Sinclair v. Interchemical*, 325 U. S. 327, especially when we find the District Court (R. 438) holding as conclusion of law 4 that the second interference record is irrelevant and immaterial, and the Circuit Court of Appeals saying (R. 460): "We think the District Court did not err in rejecting the evidence as to interferences 75,056, 75,057, and 75,058," which were the second set of interference proceedings. That evidence is material on the question of validity. Refusal to consider records and decisions bearing on the validity of a patent is contrary to *Sinclair v. Interchemical*, 325 U. S. 327, 330, wherein it was held that where invalidity appeared the Court must so find.

III. The Circuit Court of Appeals for the Sixth Circuit, in Arriving at Its Conclusion That It Would Not Follow the Findings of the Court of Customs and Patent Appeals, Reported in 141 F. 2nd. 815, Based Its Ruling on an Erroneous Assumption of Fact, Which Error Is Visually Demonstrable by an Examination of Two Small Exhibits Before This Court.

That the Circuit Court based its ruling *solely* upon the before-mentioned *single erroneously assumed*, easily controvertible, alleged fact is clear from the following excerpts from the opinion:

"This evidence relates to the bakelite blower which was part of Sperry's Exhibit No. 1." (R. 461, lines 8 and 9.)

"Only one plastic mold was made for Midwest,

and this was the only one ever made by Weis." (R. 461, lines 32 and 33.)

"The first samples of the mold were made in July 1936." (R. 462, line 1.)

"Two bakelite wheels, made by Midwest, introduced in evidence, appear to be of material and structure *identical* with that of Sperry's Exhibit No. 1." (R. 462, lines 8 to 12.) (Emphasis ours.)

"We think the testimony of the three disinterested witnesses as to the manufacture of the blower mold and the blower wheels which were a part of Sperry's first experimental model, supported by the documentary evidence from three independent companies, proves that Sperry's story of reduction to practice in 1935 is a mistake." (R. 462, last paragraph.)

"They not only support the award of priority to Mayo over Sperry in 134 Fed. (2nd) 174, but they demonstrate from Sperry's own evidence that his conception, as well as his reduction to practice, was in 1936 instead of 1935." (R. 463, lines 13 to 16.)



"Since the first machine was actually made in the latter part of 1936, and since Sperry, so far as he dates his conception at all, places it in close time connection with the making of Exhibit No. 1, these facts militate strongly against the correctness of the second decision of the Court of Customs and Patent Appeals (141 Fed. (2nd) 816)." (R. 463, lines 22 thru 28.)

"Unquestionably the first device was made some time after September 1936. Sperry did not prove conception earlier than the fall of 1936." (R. 463, lines 1 to 5 from bottom of page.)

No other fact is used as a basis for the Court's ruling.

In other words, the Circuit Court of Appeals decides counter to the six tribunals on the assumption that the Midwest blower elements (available only in 1936) are *identical* to the blower element of Sperry Exhibit No. 1. They are far from identical. The blower element of Sperry Exhibit 1 *could not come out* of the Midwest mold as clearly apparent from the following:

**Comparison of Blowers of Exhibit 1, Exhibits NN
and OO, and Exhibit M-28**

	Sperry Ex. 1 (1 Blower)	1935 Blower Mold Ex. M-28 (2 Blowers)	1936 Midwest Blower Ex. NN & OO (2 Blowers)
Maker's trade-mark on front face between a pair of blades.			No trade-mark at any place
Other markings be- tween blades	6 5890	4 5890	1 5890
Marking on center of rear face.	L.H. 22349	L.H. 22349	R.H. 22350
Thickness of blades	3/32"	3/32"	7/64"
Width of blade at base of cone	15/16"	15/16"	15/16"
Diameter of disk	3 3/4"	3 3/4"	3-9/16"
Thickness of disk	.140"	.140"	.125"
Number of blades	16	16	16
Length of blade	1 1/2" *	2 3/4"	2 1/4"

* The evidence (Ex. 20, p. 138, XQ. 121) shows that the blades of the blower used in Exhibit 1 were originally longer. L.H. signifies left hand.

On the contrary, the blower element of Sperry Exhibit No. 1 came from a mold available at least as early as 1935 (Defendant's Ex. N, pp. 288, 312, 360).

Sperry Exhibit No. 1 was not relied upon to prove either conception or reduction to practice. It was intended merely to show in a preliminary experimental manner that there might be something to Sperry's novel idea of for the first time using the non-functioning central portion of a propeller fan. Substantially all of Sperry's testimony is directed to the full-size operative models now before this Court, Exhibits 3, 4, 5, 6 and 8.

As to the blower element of Sperry Ex. 1, Sperry testified as to where he believed (P. Ex. 20, pp. 51-52) the element may have come from. The new testimony in this

suit simply shows that Sperry may have been mistaken as to *where* the blower originated but not as to its date. The date is material, not the place, and it was on the date that the Court of Appeals went astray. The Court's error on this point is so clear that Respondent did not deny it.

We are thus confronted by a clean-cut contest with six decisions overruled by the decision of the Circuit Court of Appeals on the ground, (1) of a visually determinable error of fact and (2) that new evidence not before the Patent Office does not have to be sufficient to satisfy the requirement of *Morgan v. Daniels* in overcoming the effect of a ruling by the Court of Customs and Patent Appeals.

IV. The Mayo Patent Is Invalid Because the Court of Appeals Held Invalid Claim 6 Which the Court of Customs and Patent Appeals Had Previously Indicated Was Invalid. Under the Doctrine of Triplett et al. v. Lowell et al., 297 U. S. 638, 646, Mayo's Failure to Disclaim Claim 6 Renders the Entire Mayo Patent Invalid.

However, the Court of Appeals held claim 6 of the Mayo patent invalid. The Court of Customs and Patent Appeals in *Sperry v. Payne*, *Sperry v. Teschner*, 141 F. (2nd) 816, had previously indicated that claim 6 and all other claims in the Mayo patent were invalid as shown by its finding that Sperry had reduced his invention to practice prior to the earliest alleged invention date of Mayo in that suit or in the present suit. Respondent refused to accept the findings of the Court of Customs and Patent Appeals and did not disclaim any of the claims of his patent in suit. Respondent relinquished the privilege of disclaimer and by filing a counterclaim in the present suit proceeded to relitigate in the Court of Appeals of the Sixth Circuit the claims which it was under notice were invalid. Under the

doctrine of *Triplett, et al. v. Lowell, et al.*, 297 U. S. 638, 646, Respondent filed this counterclaim at the risk of loss in the Court of Appeals in the Sixth Circuit of the other claims in the patent even though valid if the Court of Appeals of the Sixth Circuit would hold invalid any of the claims previously adjudicated. While the decision of the Court of Customs and Patent Appeals is not strictly an adjudication that claim 6, or any of the other claims of the Mayo patent, was invalid, the decision and the findings constitute notice that all the claims are invalid under the doctrine of *Radio Condenser Co. v. General Instrument Corporation*, 65 F. (2nd) 458, 459, and *Maytag Company v. Hurlley Machine Co.*, 307 U. S. 243.

The fact that the Court of Appeals held claim 6 invalid on different grounds than indicated by the Court of Customs and Patent Appeals in 141 F. (2nd) 816, does not remove this case from the disclaimer doctrine of *Triplett, et al. v. Lowell, et al.*, *supra*. In ruling out the evidence of the second interference on which the Court of Customs and Patent Appeals based its decision in 141 F. (2nd) 816, the Court of Appeals placed itself in a position where it could not hold the claims of the Mayo patent invalid for the same reasons given by the Court of Customs and Patent Appeals unless it applied the doctrine of *Morgan v. Daniels*, which it should have done but failed to do, as has been pointed out above.

The holding by the Court of Appeals that claim 6 is invalid renders all of the claims of the Mayo patent invalid under the doctrine of *Triplett v. Lowell*, *supra*.

V. Opinion of the Circuit Court of Appeals for the Sixth Circuit Runs Counter to the Doctrine of *Halliburton v. Walker*, 329 U. S. 1.

The Court of Appeals for the Sixth Circuit gives an interpretation of the *Halliburton case*, 329 U. S. 1, which is contrary to that of the Seventh Circuit in *Refrigerator Patents v. Stewart Warner*, 159 Fed. 972.

The situation in the present case is very similar to the situation in the above mentioned *Halliburton case* where the patentee was suing for an infringement on a combination having the term "means associated with said pressure responsive device for tuning said receiving means to the frequency of echoes from the tubing collars of said tubing section to clearly distinguish the echoes of said couplings from each other." This term corresponds to the following terms used in the Mayo patent in suit:

Claim 12—"means for admitting air which has passed through said radiator to the central portion of said housing." Compare this term with the structural definition given in Claim 11 which reads "a conduit leading from a relatively small area of said radiator to the central portion of said housing for conducting heated air from the former to the latter." Because of this recited structure appellee withdrew Claim 11 from its charge of infringement.

Claim 10—"means for defining different air flow paths for said respective impellers." Compare this also with the admittedly non-infringed Claim 11.

Claims 8 and 9—"means for guiding air through the radiator in separate paths." This term is based on the wall 32 and the partition 65 of the Mayo patent, but appellee contends that it is broad enough to cover the patented arrangement of appellant's device whereby such wall and partition are completely eliminated.

Claim 5—"and means within said casing for propelling air through said radiator and said discharge openings into the body of the car, and simultaneously propelling a portion of the air which is passed through said radiator to another portion of said radiator and thence through said duct."

Claim 7—"means for heating air and for circulating it through the body of the car, * * * and means for impelling air from said first named heater in contact with said auxiliary surface and through said duct into contact with the windshield."

In the *Halliburton Oil* case, *supra*, the Court refused to give the "means" clause any specific interpretation but simply held the claim invalid and *therefore not infringed*. In the Mayo patent likewise it is not seen how the "means" clauses can be given any specific construction, but such claims as Claims 5 to 10 and 12 must be held invalid as not complying with Revised Statute 4888. As the Supreme Court in *Halliburton v. Walker*, *supra*, stated (329 U. S. 13):

"Had Walker accurately described the machine he claims to have invented, he would have had no such broad rights to bar the use of all devices now or hereafter known which could accept waves. For had he accurately described the resonator together with the Lehr and Wyatt apparatus, and sued for infringement, charging the use of something else used in combination to accent the waves, the alleged infringer could have prevailed if the substituted device (1) performed a substantially different function; (2) was not known at the date of Walker's patent as a proper substitute for the resonator; or (3) had been actually invented after the date of the patent. *Fuller v. Yentzer*, *supra* (94 U. S. at 296-97, 24 L. ed. 106, 107); *Gill v. Wells*, *supra* (22 Wall. (U. S.) at 29, 22 L. ed. 711). Certainly, if we are to be consistent with Rev. Stat. 4888, a patentee cannot obtain greater coverage by failing to describe his invention than by describing it as the statute commands."

If, however, the Court were to give these "means" clauses a structural significance, then the only structural significance that can be given is the structure shown in the Mayo patent suit, or some structure which is substantially the same. *Such structures are not present in Petitioner's heaters.*

Petitioner's device is so completely different from the Mayo device that the Patent Office allowed a patent (Sperry patent 2,353,274, Rec. 143) on appellant's device after full consideration of the Mayo device. Even though Sperry lost Interference No. 73,751 with the Mayo patent, the fact that appellant obtained a patent on its radically and basically new device is conclusive proof that its device does not have substantially the same structure or operate in the same manner as the device of the patent in suit. Therefore, appellant's device and the Mayo patented device are not equivalents. Any "means" type claim which can be given an interpretation broad enough to cover appellant's device is either invalid or must be given an interpretation such that the claim is not infringed. This holds for the Mayo "means" claims 5 to 10, inclusive, and 12.

In regard to the Mayo claims 1 to 4, inclusive, certain language in these claims such as "adapted to draw another supply of air through a relatively smaller number of other of said passages to the interior of said casing" has been frowned on by the Circuit Court of Appeals in the Seventh Circuit and said to render the claim so indefinite that it is invalid (*Refrigeration Patents, Inc. v. Stewart-Warner, supra*).

In regard to the language above quoted the Court of Appeals said:

"We think the Halliburton case was not intended to eliminate the use of such convenient and uniformly understood descriptions."

It is submitted that the claim of the Mayo patent by the use of such "convenient" means terms covers completely non-equivalent devices, the very situation that the Supreme Court desired to correct in the *Halliburton case*. Petitioner's device is so completely different in structure and mode of operation that it was the basis of the Sperry patent 2,353,374 (R. 146), allowed by the Patent Office over the Mayo patent in suit (see file history of Sperry patent Ex. 35).

For the reasons stated, it is believed that the Writ should issue.

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